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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/540,234	04/03/2000	Timothy W. Conner	38-21(15726)B	1058

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EXAMINER

ZHOU, SHUBO

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 04/05/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/540,234

Applicant(s)

CONNER ET AL.

Examiner

Shubo "Joe" Zhou

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

### **DETAILED ACTION**

Applicant's amendment and request for reconsideration in Paper #6, filed on 1/23/02, is acknowledged and the amendment entered.

Currently, claims 1-2 are pending, and are under consideration by the Examiner.

Applicant's arguments in response to the previous Office Action of 10/23/01 have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous Office action are hereby withdrawn. The following rejections and/or objections are either reiterated from the previous Office action(s) or newly added, and constitute the complete set presently being applied to the instant application.

### ***Specification***

The disclosure is objected to because it contains an embedded hyperlink and/or other form or browser-executable code. Applicants are required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP ' 608.01.

This objection is reiterated from the previous Office action and maintained for reasons of record. Applicants amended the specification by deleting only http//: but the amended [www.ncbi.nlm.nih.gov](http://www.ncbi.nlm.nih.gov) etc. are still browser-executable. As a matter of factor, while the Examiner was preparing this action, he clicked the amended [www.ncbi.nlm.nih.gov](http://www.ncbi.nlm.nih.gov) and it lead him right to the NCBI website.

***Claim Rejections-35 USC § 101/§ 112***

**Claims 1 and 2 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific asserted utility or a well-established utility.**

This rejection is reiterated from previous Office action and maintained for reasons of record.

Applicant argues that the invention has utilities because it has other utilities other than the ones cited by the examiner, e.g. acquiring additional genes associated with floral development, molecular markers, promoters and cis-regulatory elements, isolating a variety of agronomically significant genes. This is not found persuasive. As set forth in the previous Office action, this list of utilities is simply a summarization of modern biotechnology. The instant specification fails to link any utility specifically to the elected polynucleotide. Further, as set forth in the previous Office action, none of these utilities is substantial. For instance, for the utility of acquiring a gene associated with floral development, simply acquiring a gene is not a real world utility. Further research has to be done in order to determine the function of the gene and the protein product encoded thereby and its involvement in a particular disorder or other real world usages. Such a clear need of further research in order to obtain a real world utility indicates that the polynucleotide is not disclosed as to a currently available substantial utility. As to applicants' argument about credibility of the asserted utilities of the invention, because the invention is not supported by a specific and substantial utility, as set forth in the previous Office action and as discussed above, even if it had utilities that were credible,

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it would not have the utilities under 35 USC 101 as detailed in the Utility Examination Guidelines, which requires that the asserted utilities be specific, substantial and credible, as set forth in the previous Office action (pages 3-4).

**Claims 1 and 2 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention. This rejection is reiterated from previous Office action and maintained for reasons of record. Since applicant's arguments for the above rejection under 35 U.S.C. 101 are not deemed persuasive, the arguments in response to this rejection are deemed non-persuasive for the same reasons as set forth above.**

***Claim Rejections-35 USC § 112, First Paragraph***

**Claims 1 and 2 are rejected, as discussed below, under 35 U.S.C. 112, first paragraph, as containing subject matter which lacks written description in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.**

This rejection is reiterated from previous Office action and maintained for reasons of record.

Applicants cite a number of case laws and argue that "the feature relied upon to describe the claimed genus must be capable of distinguishing members of the claimed

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genus from non-members", as detailed on pages 7-9 of Paper #6. However, applicants fail to point out what features distinguishing the members of the claimed genus from non-members. As set forth in the previous Office action, the claimed invention is a genus whose members have substantial variability because of the claim language of "comprising" and "fragment", one of skilled in the art would not know what features distinguish the members of the genus from non-members. For instance, in a broad sense, one amino acid residue constitutes a fragment of a plant protein, which is part of the claim limitation. If this is the case, how could the instant invention, i.e. one amino acid residue, distinguish from the non-members, which can be also one amino acid residue.

**For reasons stated above, claims 1-2 are rejected under 35 USC 112 first paragraph, also because the specification, while being enabling for polynucleotide of the SEQ ID NO:1, in claims 1-2, does not reasonably enable nay person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurable in scope with these claims.**

This rejection is reiterated from previous Office action and maintained for reasons of record.

***Claim Rejections-35 USC § 112***

The following is a quotation of the **second** paragraph of 35 U.S.C. 112:

**The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.**

Claims 1-2 are rejected under 35 U.S.C. 112 , second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "a nucleic acid sequence selected from the group consisting of SEQ ID NO:1" in claim 1 and its dependent claim is vague and confusing. How could one sequence make : a group? Does the group consist: of sequence other than that of SEQ ID NO:1?

### ***Conclusion***

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to:

Shubo "Joe" Zhou, Ph.D., whose telephone number is (703) 605-1158. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst Tina Plunkett whose telephone number is 703-305-3524, or to the Technical Center receptionist whose telephone number is (703) 308-0196.

S. "Joe" Zhou, Ph.D.

Patent Examiner



**MICHAEL BORIN, PH.D**  
**PRIMARY EXAMINER**

